

Application No.: 09/655481

Docket No.: 47171-00125USC2

Remarks

Claims 1, 72, 73, 79, 81 and 83-99 have been amended. Claims 1 and 72-99 are pending.

As originally written claims 83-99 did not invoke 35 U.S.C. §112, ¶6 as the claims do not recite the phrase “step for” and do recite acts. In the present amendment, claims 83-99 have been amended to explicitly recite “the acts of” or “the act of” to make even more clear that none of the limitations in any of these claims invoke 35 U.S.C. §112, ¶6. Rather, where a limitation falls within 35 U.S.C. §112, ¶6, to aid in the public notice function of the claims, Applicants have explicitly recited either the phrase “means for ...” or “step for ...” for those limitations invoking 35 U.S.C. §112, ¶6.” Similarly, to aid in the public notice function of the claims, limitations which do not explicitly recite the phrase “means for” or “step for” do not invoke 35 U.S.C. §112, ¶6.

I. §112, ¶2 Rejections

In the Office Action dated June 16, 2004, claims 1, 72, 79, and 81-82 were rejected under 35 U.S.C. §112, ¶2. More specifically, it was stated that the phrase “the value” lacked suitable antecedent in claim 1, line 10; claim 72, line 10; claim 79, line 8, and claim 81, line 10.

Claims 1, 72, 73, and 81 have been amended to recite “each bill having a value associated therewith.” Claim 79 has been amended to recite “bills to be transported having a value associated therewith.” These amendments are believed to overcome the §112, ¶2 rejection by providing an antecedent basis for the phrase “the value”. These amendments are not believed to change the scope of the claims.

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II. §101 Double Patenting Rejections

In the Office Action dated June 16, 2004, claims 83-99 were rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 42-58 of U.S. Pat. No. 6,351,551 ("the '551 patent").

This rejection is respectfully traversed. Rejected claims 83-84 recite the act of transferring bills to "a single output receptacle." Rejected claims 85-99 recite the act of feeding bills to "a single output receptacle." Conversely, claims 42-58 of the '551 patent are not so limited, but rather their scope covers the transferring or feeding of bills to more than a single output receptacle. For example, independent claims 44, 49, 51, 55, 57 of the '551 patent recites the act of feeding bills to "one or more output receptacles." Independent claims 42 and 43 of the '551 patent recite transferring bills to "an output receptacle". As well recognized in the patent law, the indefinite articles "a" and "an" in claims using the transitional phrase "comprising" means "one or more". *Scanner Technologies Corp. v. ICOS Vision Systems Corp.*, 365 F.3d 1299, 1304 (Fed. Cir. 2004).

Accordingly, claims 42-58 of the '551 patent have a different scope than claims 83-99 of the present application. Thus, it is respectfully requested that the §101 double patenting rejection be withdrawn.

II. Obviousness-Type Double Patenting Rejections**A. Obviousness-Type Double Patenting Rejection Based on the '697 Patent**

In the Office Action dated June 16, 2004, claim 1 was rejected under the judicially created doctrine of obviousness-type double patenting over claim 5 of U.S. Pat. No. 5,790,697 ("the '697 patent").

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Applicants respectfully traverse this rejection. Applicants do not believe that the Office Action has correctly compared or characterized the various claims discussed in connection with this rejection. Applicants are also unable to determine which “feature” of claim 5 of the ‘697 patent the Office Action asserts to be extraneous. The citation to col. III, lines 24-26 of the ‘697 patent does not seem to make sense. Moreover, Applicants traverse any assertion that such a limitation is “extraneous”. Applicants do not understand how a limitation of a claim can be said to be “extraneous.” Applicants also traverse any assertion that it would be obvious to “exclude such a extraneous feature” or that claim 1 of the ‘697 patent teaches such a modification and point out that claim 1 of the ‘697 patent is not prior art to the present application.

Additionally, to advance the prosecution of this application, a terminal disclaimer accompanies this amendment.

B. Obviousness-Type Double Patenting Rejections Based on the ‘551 Patent

In the Office Action dated June 16, 2004, claims 72-82 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-3, 6-7, 9, and 13-16 of U.S. Pat. No. 6,351,551 (“the ‘551 patent”).

Applicants respectfully traverse this rejection. Applicants do not believe that the Office Action has correctly compared or characterized the various claims discussed in connection with this rejection. Although not clear, it appears that the Office Action may be stating that claim 72 of the present application recites a “single output receptacle.” This is incorrect. Claim 72 recites “an output receptacle”. As mentioned above, the article “an” means “one or more” in claim 72 which uses the term “comprising.” When Applicants mean “single” that term is expressly

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recited. For example, pending claim 76 recites "a single output receptacle." Where the term "single" does not appear, single is not a limitation.

Applicants also traverse the reference to "Smith". Applicants do not know to what reference this is referring and thus can not respond. Accordingly, the reference to "Smith" is improper and Applicants respectfully request that it be withdrawn.

Finally, Applicants traverse the arguments suggesting that the use of a single output receptacle as opposed to the use of multiple output receptacles in the recited combinations would have been obvious. The use of a single output receptacle in some embodiments, e.g., claim 76, provides many advantages and solves a number of problems. For example, the use of a single output receptacle in the claimed combination can contribute to a machine which is smaller and less expensive. Moreover, the rejection is improper because it has failed to point to any prior art and fails to contain any references in support of the unfounded and erroneous contentions advanced as to what one of ordinary skill in the art would have expected. Applicants respectfully request that they be withdrawn.

Additionally, to advance the prosecution of this application, a terminal disclaimer accompanies this amendment.

Conclusion

It is the Applicants' belief that all of the claims are now in condition for allowance, and action towards that effect is respectfully requested. It is believed that no fee is presently due; however, should any additional fees be required (except for payment of the issue fee), the Assistant Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47171-00125USC2.

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If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

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Respectfully submitted,

By 

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